

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1, 3-6, 8-11, and 13-18 are currently pending in this application. Claims 1, 11, and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1 and 11.

Rejections under 35 U.S.C. § 103

Claims 1, 3-6, 8-11, and 13-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,633,888 ("Kobayashi") in view of admitted prior art (APA) per the affidavit filed 9/24/2004, which included the Anne Thomas' White paper, and further in view of WorkFlow Template – Using the WFT Development Environment ("WFT"). This rejection is respectfully traversed.

The independent claims of the present invention are directed toward a method of creating Java Embedded Server (JES) bundles using a manifest generator tool provided within a module that is executed in an Integrated Development Environment (IDE) (*see, e.g.*, Figure 7 and accompanying text on page 6-7 of the specification). The manifest generator tool is used to create and edit manifest files which are subsequently used to create a JES bundle (*see* Figure 10 and accompanying text on pages 8-9 of the Specification). The independent claims recite that the manifest generator tool chooses a template that includes manifest headers for a manifest file. In one embodiment of the invention, the manifest generator tool includes a bundle-writer responsible for automatically filling in the values corresponding to each manifest header

included in the template. Subsequently, upon including the names and values of the manifest headers, the source files associated with the JES bundle are parsed to generate the manifest file for the JES bundle. Using the aforementioned pieces of information, the bundle-writer then packages a JES bundle by selecting the contents to be packaged, where the contents include the generated manifest file(s) (*see* Specification, page 9).

To establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (*See* MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (*See* MPEP §2143.03). The Applicant respectfully asserts that the references, when combined, fail to teach or suggest all the claim limitations of amended independent claim 1.

As an initial matter, Applicant asserts that there is no motivation to combine Kobayashi or APA with WFT. The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

Kobayashi discloses creating and testing object oriented components using visual programming systems (*i.e.*, a visual builder). APA is a white paper on the Java Embedded

Server (JES) technology. In the present case, there is no expression of desirability in either Kobayashi or APA that would cause one skilled in the art to turn to the teachings of WFT to achieve the claimed invention. WFT discloses a *workflow environment tool* that is used in a business cycle for the creation and completion of documents by users associated with the same company/organization. A workflow product is meant to be an internal product that is used to efficiently complete tasks within a company/organization. Neither Kobayashi nor APA contains any disclosure that would even remotely suggest turning to a workflow environment tool for any purpose. Kobayashi relates to high-level programming/code development, while APA describes a server that is used to support embedded applications that run on microcomputers embedded within electronic devices (*see* APA, page 1). Document production and manipulation, which is the subject matter of WFT, is in no way related to Kobayashi or APA. Applicant is perplexed and unable to conger up any reason why such references would ever be combined by someone skilled in the art, much less combined to render the present invention obvious.

Even assuming *arguendo* that WFT is combinable with Kobayashi and APA, WFT fails to disclose or suggest the limitations of the claimed invention. In particular, the Examiner relies on WFT for disclosing the steps performed by the JES manifest generator tool, which include, in part: (i) choosing a template comprising a plurality of manifest headers; (ii) filling in the values corresponding to each of the manifest headers by a bundle-writer; (iii) generating the manifest file for the JES bundle by parsing at least one source file associated with the JES bundle; and (iv) packaging the JES bundle to obtain a package that includes the generated manifest file.

All the steps performed by the manifest generator tool are specifically tied to the creation of a JES bundle. That is, the language of the claims explicitly ties each of the steps performed by the JES manifest generator tool to JES bundles or manifest files. WFT has nothing to do with

JES bundles or JES manifest files. In fact, WFT only discloses basic computer techniques such as “dragging and dropping” (*see* WFT, page 2-26) and text entry (*see* WFT, page 2-27). These computer techniques are not directed toward the generation of JES bundles and do not use manifest headers associated with a manifest file that is packaged to form the JES bundle. Furthermore, WFT fails to disclose or suggest a bundle-writer for filling in the values corresponding to each manifest header. WFT also fails to teach or suggest parsing a source file associated with the JES bundle.

Turning to Kobayashi and APA, the Examiner admits that Kobayashi fails to disclose or suggest JES bundles and a JES manifest file. However, Kobayashi fails to disclose or suggest more than just JES bundles and JES manifest files. Kobayashi does not teach or suggest an IDE for executing a module with a plurality of development tools for the purpose of generating JES bundles. Rather, the IDE disclosed in Kobayashi is part of a visual environment add-on (VEA) and uses a Java bean compiler to produce beans (*i.e.*, beans contained in JAR files) that are used by the visual builder. The IDE of Kobayashi is not used to generate any type of bundles using a manifest generator tool that allows the generation of JES bundles easily by providing the header information for each manifest file, as recited in the independent claims of the present invention. The Examiner’s attempt to extend Kobayashi to teach this recited portion of the claims is improper and results in reading out the express language of the claims. The Examiner should consider all words in the claim and not just use a general reference to the subject matter as teaching the precisely worded claim. In fact, Kobayashi does not even disclose a manifest generator tool in relation to an IDE, nor does Kobayashi disclose an IDE in relation to JES bundles.

Further, APA fails to provide that which Kobayashi lacks. APA discloses that JES (Java Embedded Server) is an application server designed for embedded software that allows a device to dynamically install and execute a Java application. APA only discloses the definition of JES, and does not teach or suggest anything even remotely related to the creation of JES bundles. APA does not contemplate the generation of JES bundles using an IDE and tools that make creation of JES bundles easier. In addition, as admitted by the Examiner on page 4 of the Office Action mailed December 22, 2005, APA is completely silent with respect to a manifest generator tool, and thus cannot possibly disclose a manifest generator tool that performs the aforementioned steps to create manifest files for JES bundles within an integrated development environment. Again, merely teaching a term found in the claims does not amount to teaching the concept claimed.

Thus, it is clear that neither Kobayashi nor APA disclose a manifest generator tool *in an IDE* for the generation of JES bundles. Moreover, WFT fails to supply that which Kobayashi and APA lack. Particularly, WFT relates to a workflow tool that allows a project to be laid out from start to finish. Specifically, WFT discloses a development environment for the automatic routing of documents to users responsible for working on them (*see* WFT, page 2-26). Workflow is concerned with providing the information required to support each step of the business cycle and enables this process with a tool box that provides methods of interaction between users and documents that are part of the workflow (*see* WFT, Figure 2-3 and page 2-25).

In view of the above, it is clear that independent claims 1, 11, and 18 are patentable over Kobayashi, APA, and WFT, whether considered separately or in combination. Dependent

claims 3-10 and 13-17 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

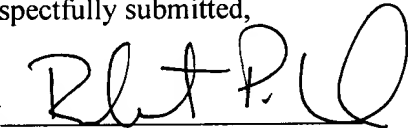
Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 14695/007001).

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Respectfully submitted,

By



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